

**REMARKS**

Applicant has reviewed the Office Action mailed December 15, 2003. Claims 1 through 19 are pending in the present application. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

**Claim Rejection – 35 U.S.C. §103**

Claims 1 through 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,025,837 (“Matthews”) in view of U.S. Patent No. 5,585,865 (“Amano”). Applicant respectfully traverses this rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Independent claims 1, 6, 11, and 16 recite maintenance of “a subset of program information for at least one related program of a given program with program information for the given program in an information handling system” and “providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program” (emphasis added). The information on program related through the at least one related program and associated with the subset of program information for the at least one related program includes: “episodes of recurring programs, segments of a multi-part program, programs with similar content, and programs related through an intermediate program .... An example of the last type of relationship could be a program that has content about bears’ feeding habits, including eating salmon. The bear program could be related to a program about stocking fish, including salmon, which is further related to a program about fishing in artificially stocked rivers.” (Specification, page 2, lines 7-13; page 12, line 16 to page 13, line 15) (emphasis added). Thus, the present invention provides information concerning related programs to the given program. However, the present invention also provides information on programs related, through the related programs (a.k.a., intermediate programs), to the given program. In other words, the present invention provides another subset of information, such as further alternative programs, which are

related to the at least one related program which itself is a subset of information to the given program.

The Examiner correctly states that the Matthews reference fails to disclose, teach or suggest "providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program," as recited in claims 1, 6, 11, and 16 of the instant application. To correct this defect the Patent Office offers the Amano reference. The Examiner refers to Figs. 3-4 & 7, of the Amano reference, for teaching a television receiver system using an electronic guide program guide for providing program information and related program with information in a subset form of program information on a display to the user. Further, the Examiner states, "[i]n other words, related programs or recurring programs of similar type or genre can be identified, either by the user input or automatically recognized by the system, and related programs are offered to the user for selecting and viewing" (Office Action, page 3). The Examiner, to support this statement, offers col. 1/lines 15-30, col.2/lines 12-25, col.2/lines 30-52, and col. 6/line 22 to col. 7/line 22 of the Amano reference.

The Examiner is correct in stating that the Amano reference teaches to a user inputting a "genre code" and having that code utilized to provide information which may be displayed to the user. However, this is not the present invention. Amano teaches to a remote controller 11 including a plurality of genre buttons associated with a particular genre/type of program. (Amano, col. 2/line 67 through col. 3/line11). Further, FIGS. 7 and 8 and col. 8/line 42 through col. 9/line 11, of the Amano reference, illustrate and describe how those genre buttons are assigned their individual genre (codes) associations by the user of the remote controller 11. Then in col. 6/line 7 through col. 7/line 23 of the Amano reference, an example of the functionality of the invention of Amano is provided. In this example, Amano clearly states:

"if a 'Sports' genre button (FIG. 2) is pressed (step 44), EDS data about the current channel is extracted by the slicer 21 connected to the video signal detector 4. The extracted EDS data is temporarily stored in the microcomputer 13. This processing is performed on all available channels sequentially (step 45). Based on the stored EDS data, the microcomputer 13 determines whether the program of the genre specified by the genre

button is being broadcast or not (step 46). If the microcomputer 13 determines that the program belonging to the specified genre is being broadcast only in one channel (step 47), the microcomputer 13 switches the tune-in control signal for the tuner 2, thereby outputting the program of the specified genre to the CRT 24 (step 48).

(Amano, col. 6/lines 9-22) (emphasis added). Instead of providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program, as recited in the claims of the instant application, Amano teaches to a remote control requiring a user to press a button, which has been assigned a genre code through the process outlined in Figs. 7 and 8, and then switching the channel being displayed to a secondary channel which matches the genre code selected by the user. The Amano reference, in col. 6/line 23 through col. 7/line 23, provides a description of the inventive function when more than one channel or no channels are found which match the user assigned and selected genre code corresponding to the genre button on the remote control. Amano further provides for a timer functionality. However, these functions, which are based off the user selection of a genre code relayed to a microcomputer do not disclose, teach, or suggest the present invention.

Amano is further contrasted to the present invention by the fact that the Amano invention does not necessarily provide/display information related to a program which is itself either related to a primary program or is related to an intermediate program related to the primary program, as is provided by the present invention. Amano simply provides a shortcut (depressable button) to a user to enable them to receive information on pre-specified subject matter (genres) which they are interested in. These buttons or the genres which they associate are not necessarily related to the program currently being tuned by the microcomputer. Still further, Amano states, "[a] channel frequently viewed within, for example, one week before in the generally same time zone, or period, is read from the frequency memory 19 and selected, or tuned in, automatically (steps 42, 43)." (Amano, col. 5/lines 57-60). This associative processing provided by the Amano reference is not the present invention. For these further reasons Applicant respectfully submits that the Amano reference does not disclose, teach, or suggest the claimed limitations of the present invention.

As the Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Patent Office does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Office has selected portions from two references to arrive at the present invention; however, neither reference supplies the motivation for combining the references as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

In making the rejection under 35 U.S.C. § 103, the Patent Office first asserts Matthews for disclosing a method for performing events for related programs. The Patent Office correctly notes that Matthews does not explicitly teach a "providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program" and offers Amano to correct this defect of the Matthews reference. The Patent Office states that it would have been obvious to modify Matthews according to Amano due to a user's desire to have easy tuning and program selecting capabilities. However, Amano teaches a

remote controller 11 including a plurality of user selectable buttons 33 which the user must depress in order to send a signal to a microcomputer 13 regarding a user defined genre code, from which the microcomputer 13 may generate and display information from, while Matthews teaches an electronic program guide (EPG) with hyperlinks to target resources. Neither of the references teaches or suggests combining the genre code selection capabilities of Amano with the EPG system of Matthews.

Further, even if the references could be combined, the combination would not provide the claimed invention. A genre code transmittal and receiving system of Amano combined with the EPG with hyperlinks of Matthews does not teach or suggest the present claimed invention. Rather than the providing of information on programs related through the at least one related program and associated with the subset of information related to the given program disclosed by the present invention, the combination of the above references would provide essentially the same search system that allowed the user to navigate a menu and access hyperlinks for information associated with the given program. Thus, the references fail to provide the claimed invention and carry the burden of showing obviousness.

Claims 2, 7, and 12 are believed to be allowable based on dependence from independent claims 1, 6, 11, and 16, respectively. However, the rejections of the dependent claims are respectfully traversed for the following additional reasons.

Dependent Claim 2 recites “maintaining the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)” (emphasis added).

By contrast, the Matthews reference fails to disclose, teach or suggest maintenance of “the subset of program information for the at least one related program....” The Patent Office refers to Fig. 5 as illustration for an EPG, and Fig. 4/item 96 for a program memory for maintaining the program information EPG in section 104 of the Matthews reference as disclosing maintenance of a subset of program information for at least one related program. However, column 8, lines 54-57 of the Matthews reference clearly identifies the purpose and function of section 104, this passage reads:

An EPG application 104 is stored in program memory 96 and executes on the processor 92 to organize programming information downloaded from the EPG server at the headend.

Matthews column 8, lines 54-56 (emphasis added). Thus, application 104 of the EPG does not maintain a subset of information on at least one related program. Instead, application 104, simply organizes “programming information downloaded from the EPG server at the headend.” Matthews column 8, lines 55-56.

Dependent claim 7 recites “wherein said program of instructions further includes instructions configured to maintain the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)” (emphasis added).

By contrast, the Matthews reference fails to disclose, teach or suggest maintenance of “the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)”. The Patent Office refers to Fig. 4 and column 8/lines 20-67 of the Matthews reference as disclosing maintenance of the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG). The relevant section of this passage reads:

A channel navigator application 102 is stored in program memory 96 and executes on the processor 92 to control the tuner(s) 98 and 100 to select a desired channel for receiving the video content programs. An EPG application 104 is stored in program memory 96 and executes on the processor 92 to reorganize programming information downloaded from the EPG server at the headend. The EPG 104 supports a displayable user interface (UI) which visually correlates programs titles to scheduled viewing times and tuning information, such as a channel, as will be described below with reference to Fig. 5. The user interface unit 90 also has a browser 106 which is kept in memory 96 and dynamically loaded on processor 92 when needed to render content, such as a hypertext document, form an ISP or other content provider. The browser can be implemented as a hyperlink browser, or more particularly, as an Internet Web browser.

Matthews column 8, lines 52-67. As can be seen from the Matthews reference, Fig. 4 and the written description of column 8, lines 52-67, it is a “program memory 96” which in

fact stores a "operating system 101", "channel navigator application 102", "EPG application 104" and a "browser 106" and not the electronic program guide which is maintaining program information for the given program, including the subset of program information for the at least one related program.

Dependent claim 12 recites "[t]he computer readable medium of Claim 11 wherein said program of instructions further implements maintaining the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)" (emphasis added). The Patent Office refers to the reasons given in the scope of method and system claims 2 and 7 for making this rejection. However, this rejection fails for the same reasons as stated for the failure of the rejections of claims 2 and 7.

Claims 3, 8, 13, and 17 are believed to be allowable based on their dependence from independent claims 1, 6, 11, and 16, respectively. However, the rejection of the claims is respectfully traversed for the following additional reasons.

Dependent claims 3, 8, 13, and 17 recite obtaining user input based on the information provided and performing program events based on the user input. This includes obtaining user input and performing program events based on user input from the information associated with the subset of program information for the least one related program of the given program provided by independent claims 1, 6, 11, and 16 from which claims 3, 8, 13, and 17 depend.

By contrast, the Matthews reference fails to disclose, teach, or suggest the providing of information associated with the subset of program information for the least one related program of the given program. The Patent Office refers to Fig. 5, and column 9/line 55 to column 10/line 14 of the Matthews reference as disclosing the providing of information associated with the subset of program information for the at least one related program. The Patent Office argues that this is accomplished by the "MORE" 140 hyperlink, the "Last week" hyperlink and the "Comedy Club" hyperlink of the Matthews reference, which a viewer can access through the EPG. For the same reasons, as stated under the argument for independent claim 1, this argument fails.

The EPG UI 110 also includes hyperlinks 140 integrated as part of the grid. The hyperlinks are supplied with the program records received from the headend 22. These hyperlinks can be inserted into the channel tiles 122, program tiles 124, or the description window 128. In the Fig. 5 illustration, the hyperlink "More" is provided in the description window 128 to reference target resources that contain additional information about this episode of the Seinfeld show. Other Hyperlinks in the description window 128 include "Last Week" which references a target resource containing information on the previous week episode, and "comedy club" which links to a target resource having video coverage of comedian Jerry Seinfeld performing at night clubs. The target resources referenced by the hyperlinks might be located at the headend (Fig. 1 implementation), or at an independent service provider (Fig. 3 implementation). The target resource might further be located locally, having been pre-cached by the system. For instance, the system might pre-cache supplemental information about certain shows before they air based on predictive viewing tendencies, or as part of a promotional data broadcast advertising the show. This permits local interactive functionality between the viewer and viewer computing unit, in addition to full network interactive functionality between the viewer and the program provider.

Matthews column 9, line 56 through column 10, line 13 (emphasis added). The Matthews reference teaches a user interface which provides access to hyperlinks, which then provide websites that contain the "additional information about this episode". Thus, it is not the user interface of the Matthews reference but the websites that provide additional information. Further, the user interface in the Matthews reference does not disclose, teach, or suggest providing information on programs related through at least one related program and associated with the subset of program information for the at least one related program to a user, as disclosed by the present application; instead, the Matthews reference is limited in scope to providing hyperlinks to websites including information related to the current program. The scope of the supplemental information accessible through the hyperlinks, as outlined in the Matthews reference, is described in the Matthews reference at Fig. 1 and column 7, lines 16 through 21. This passage reads:

Examples of possible supplemental content include interactive questions or games related to the program, additional trivia on the movies or TV shows, advertisements, available merchandise or other memorabilia, Web pages to programs of similar type or starring the same actors/actresses, and so on.



Matthews column 7, lines 16 through 21. Thus, the scope of the Matthews reference does not include the limitation of providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program (emphasis added). The “hyperlinks” in the Matthews reference are provided for the purpose of helping a viewer to identify websites associated with a particular program. This is described in the Matthews reference column 4, lines 59-65. This passage reads:

By integrating the hyperlinks within the EPG UI, the viewer can readily identify supplemental information to the programs and access that information directly from the EPG. The viewer no longer needs to remember that there may be a Web site associated with a particular program or channel, nor is the viewer relegated to surfing the Internet from a separate machine to find any related content.

Matthews column 4, lines 59-67 (emphasis added). This identifies that the purpose of these hyperlinks, in the Matthews reference, is to provide Internet access to websites through the EPG, not to provide information on programs related through the at least one related program and associated with the subset of program information for the at least one related program (emphasis added).

Claims 4, 5, 9, 10, 14, 15, 18, and 19 are believed to be allowable based on dependence from independent claims 1, 6, 11, and 16. However, the rejection of the dependent claims is respectfully traversed for the following additional reasons.

Dependent claim 4 recites “wherein the action of performing program events includes recording the given program and the at least one related program” (emphasis added).

By contrast, the Matthews reference fails to disclose, teach or suggest the recording of a given program and the at least one related program. The Patent Office refers to Fig. 8/step 216 and column 12/lines 18-29 of the Matthews reference as disclosing the recording of a given program and the at least one related program. This passage reads:

On the other hand, suppose that the time is only 8:00 PM, and the Seinfeld program is not scheduled to start for another hour. In this case (i.e., the “no” branch from step 210), the user interface unit can perform one or two operations. First, the user interface unit can invoke some code to reference a target resource having information on the Seinfeld program (step 214 in Fig. 8). For instance, the instruction might call for invoking the Web browser 106 to render an NBC Web page for information on “Seinfeld.” A second operation might be to initiate a routine which will record the program “Seinfeld” when the program begins playing at 9:00 PM (step 216 in Fig. 8)

Matthews column 12, lines 18-29 (emphasis added). However, this “routine which will record the program Seinfeld” in the Matthews reference does not include recording an at least one related program as well. Instead, the “routine” is only enabled to record the given program “Seinfeld” or invoke a Web browser.

Dependent claim 5 recites “wherein the subset of program information is appended to the program information for the given program.”

By contrast, the Matthews reference fails to disclose, teach or suggest appending the subset of program information to the program information for a given program. The Patent Office refers to column 9/line 34 to column 10/line 20 of the Matthews reference as disclosing that, “as the user clicks on the program information of the given program, the subset of program information is displaying.” However, the “subset of program information” to which the Patent Office refers, as described by the Matthews reference column 9, line 34 to column 10, line 20, is either descriptive text about the given program or hyperlinks to websites and does not include appending the subset of program information, including program information associated with the subset of program information, to the program information of the given program.

Dependent claim 8 recites providing information on programs related through the at least one related program and associated with the subset of program information for the at least one related program to a user; obtaining user input based on the information provided; and performing program events based on the user input.

By contrast, the Matthews reference fails to disclose, teach or suggest “providing information on programs related through the at least one related program and associated

with the subset of program information for the at least one related program.” The Patent Office refers to Fig. 5, and column 9/line 55 to column 10/line 14 of the Matthews reference as disclosing the providing of information associated with the subset of program information for the at least one related program. The Patent Office argues that this is accomplished by the “MORE” 140 hyperlink, the “Last week” hyperlink and the “Comedy Club” hyperlink of the Matthews reference, which a viewer can access through the EPG.

By integrating the hyperlinks within the EPG UI, the viewer can readily identify supplemental information to the programs and access that information directly from the EPG. The viewer no longer needs to remember that there may be a Web site associated with a particular program or channel, nor is the viewer relegated to surfing the Internet from a separate machine to find any related content.

Matthews column 4, lines 59-67 (emphasis added). This passage recites the providing of hyperlinks to “a Web site associated with a particular program” and not providing information on programs related through the at least one related program and associated with a subset of program information for an at least one related program.

Dependent claim 9 recites “a recording device.”

By contrast, the Matthews reference fails to disclose such a “recording device.” The Patent Office refers to Fig. 8/item 216, and column 9/lines 45-55 of the Matthews reference as disclosing a recording device. However, Fig. 8, step 216 indicates only a procedure to “initiate recording procedures.” Further, the written description of step 216, located at column 12, line 27 of the Matthews reference discloses only “to initiate a routine which will record the program.” Further, the Matthews reference does not identify initiating a recording routine for anything but the given program. Additionally, the Patent Office refers to column 9, lines 45-55 of the Matthews reference as disclosing a recording device. This passage reads:

by the headend 22 from the EPG server 44. The data maintained in data structure 48 (Fig. 2) is transmitted as program records to the user interface unit and cached in local memory. Data records for upcoming programs can be downloaded on a periodic basis, or alternatively, individual data records for certain programs and channels can be selectively transmitted in

response to viewer requests. The EPG 104 inserts the appropriate data records into the EPG UI for display as the viewer maneuvers the focus frame 126 around the grid.

Matthews column 9, lines 45-55 (emphasis added). Nowhere in this Matthews reference is a recording device taught, disclosed or suggested. Instead, the cited passage is discussing “data records” for “upcoming” or “certain” programs.

Dependent claim 10 recites “wherein the subset of program information is appended to the program information for the given program.”

By contrast, the Matthews reference fails to disclose, teach or suggest appending the subset of program information to the program information for a given program. The Patent Office refers to column 9/line 34 to column 10/line 20 of the Matthews reference as disclosing that, “as the user clicks on the program information of the given program, the subset of program information is displaying.” However, the “subset of program information” to which the Patent Office refers, as described by the Matthews reference column 9, line 34 to column 10, line 20, is either descriptive text about the given program or hyperlinks to websites and does not include appending the subset of program information, including program information on programs related through the at least one related program and associated with the subset of program information for the at least one related program, to the program information of the given program, as disclosed by the instant application.

Claims 11-19 recite “a computer readable medium tangibly embodying a program of instructions implementing the method above ... in an information handling system; providing information on programs related through the at least one related program and associated with the subset of program information for at least one related program” and “a signal tangibly embodied in a propagation medium comprising at least one instruction configured to maintain, in an electronic program guide (EPG), a subset of program information for at least one related program of a given program with program information for the given program; at least one instruction configured to provide information on programs related through the at least one related program and associated with the subset of program information for the at least one related program; and at least

one instruction configured to perform at least one program event for the given program and, based upon the subset of program information, the at least one related program and the information associated with the subset of program information for the at least one related program." (emphasis added).

For the reasons stated above, the Matthews reference in combination with the Amano reference does not carry the burden of a showing of obviousness. Thus, Applicant submits that independent claim 11, and claims 12-15 which depend from claim 11, and independent claim 16, and claims 17-19 which depend from claim 16, are allowable. Therefore, Applicant respectfully requests that the §103 rejection be withdrawn and claims 11-19 be allowed.

### CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims 1-19 is earnestly solicited.

Respectfully submitted on behalf of  
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